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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,374	07/30/2003	Jean-Pierre Salaun	16721-0210 (42528-288279)	8956
20306 7590 02/09/2007 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER GEMBEH, SHIRLEY V	
			ART UNIT	PAPER NUMBER
			1614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/630,374	Applicant(s) SALAUN ET AL.	
	Examiner Shirley V. Gembeh	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8, 11, 14-18 and 21-24 is/are pending in the application.
4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8, 11, 21-24 is/are rejected.
- 7) ☒ Claim(s) 21-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed **April 10, 2006** and January 23, 2006 presents remarks to the non-compliance mailed February 7, 2006 and the remarks response to the arguments of the office action mailed **October 20, 2005**. Applicants' request for reconsideration of the rejection of claims in the last office action has been considered and entered.

Examiner hereby acknowledges the receipt of the affidavit of 4/10/06 has been fully considered but not persuasive.

Affidavit

The affidavit submitted on January 23, 2006 is acknowledged, however, did not overcome the rejection because: the compound is the same as the compound used in the instant claims and the references show that the compound has the characteristics of inhibiting differentiation of a fibroblast to an adipocyte.

Status of claims

Claims 1-3, 4-5, 9-10, 12-13, and 19-20 have been cancelled.

Claims 14-18 have been withdrawn and claims 6-8, 11, 21 and 22 have been amended.

Claims 23 and 24 are new.

Claims 6-8, 11, 21-24 are pending in this office action.

Claim objection

Claims 21-24 are objected to because of the following informalities: The word nutraceutical or nutraceutical should be used consistently. It is noted that it is spelled

differently in the specification (see pg. 11) and spelled differently in the claims (23 and 240. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

II. Claims 6-8, 11 and 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has not provided a description of the nutraceuticals nor a description of its contents.

In other words, the Applicant has not described with sufficient clarity a nutraceutical..

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's arguments, filed, with respect to the above rejection on the record have been fully considered and are unpersuasive and is repeated below to include newly added claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6-8, 11, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbertsson et al., J. of Lipid Research, 1998 Vol 39, pages 237-244 (of record) and Yani et al., US 5,696,166 in view of Wollard. Prostaglandins 1989, Vol. 38 (4) pages 465-471 and Gaillard et al. Bio.chem.. J. (1989) 257, 389-397.

Herbertsson et al., teach (on page 240, right hand side column underlined), of the detection of 12(S)-HETE to other cells, and in the discussion section on page 242 teach of the expression in preadipocytes which appears to inhibit differentiation to adipocytes. It is known in the art that fibroblast are connective tissue cells that makes and secretes collagen proteins. Preadipocytes are present throughout adult life in

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adipose tissues and can proliferate and differentiate into mature adipocytes according to the energy balance. Herbertsson used 5 different cell lines, 3T3-L1 binds approximately the same amount of 12(S)-HETE as lewis lung indicating that once the cells are differentiated to adipocytes the binding capability was reduced, these cells were however used as a negative control as they do not produce 12(S)-HETE, further in the reference (page 240 left column Herbertsson showed reduced binding with 12-HETE, (see also at page 242 right hand col., sec. para.), states that TNF-induced c-fos expression which appears to be dependent on formation of HETEs prevented differentiation to adipocytes.

Yani teaches 12-hydroxy-5,8,14-(Z)-10-(E)-eicosatetraenoic acid (12-HETE) composition (see col. 4 lines 1-55) wherein the composition is administered in the form of gel (see col. 5 lines 27) as in claims 6 and 11, where the 12-HETE comprises of 12(R) or (S)-HETE column 6 line 50, as in claim 7 and 8.

Wollard teaches of a racemic 12(R,S)- HETE compounds (see abstract) administered topically to humans in effective concentrations (see abstract). Topical application is assumed to be in a form of a patch, gel or cream as topical application is always given as a cream, patch or a gel (thus nutraceuticals) as taught by Yani.

Gaillard et al. teach (see page 391, right hand col. first para-highlighted sec) that 12-HETE induced a low irreproducible adipose) thus inhibition of differentiation of adipose.

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One of ordinary skill in the art would have combined the above cited art and applied topically or given as a nutraceutical a composition comprising 12-HETE to inhibit adipose differentiation because the prior art teaches that these compounds inhibit differentiation of adipose. The motivation comes from the combination of the cited prior art.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembel whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SVG
6/14/06

Ardin H. Marschel 2/4/07
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER